

ESTTA Tracking number: **ESTTA420263**Filing date: **07/18/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Outsell, Inc.		
Entity	Corporation	Citizenship	California
Address	330 Primrose Road, Suite 510 Burlingame, CA 94010 UNITED STATES		

Attorney information	Christine B. Redfield K&L Gates LLP 630 Hansen Way Palo Alto, CA 94304 UNITED STATES SFDocket@klgates.com Phone:(650) 798-6700
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Registration Subject to Cancellation

Registration No	3758243	Registration date	03/09/2010
Registrant	THE MCCORMICK TEAM, INC. SUITE #358 MALIBU, CA 90265 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2009/05/06 First Use In Commerce: 2009/05/06 All goods and services in the class are cancelled, namely: prerecorded electronic media, namely, audio and video cassettes, CDs and DVDs all featuring information on business, communications, leadership, management, marketing and sales strategy presented through speeches, sound effects and music; downloadable webcasts and podcasts featuring music and audio books
Class 016. First Use: 2009/05/06 First Use In Commerce: 2009/05/06 All goods and services in the class are cancelled, namely: paper and printed matter, namely, printed publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all featuring information on business, communications, leadership, management, marketing and sales strategy; photographs mounted and unmounted; posters; postcards; printed greeting cards; printed educational, instructional and teaching materials on business, communications, leadership, management, marketing and sales strategy; series of non-fiction books on business, communications, leadership, management, marketing
Class 035. First Use: 2009/05/06 First Use In Commerce: 2009/05/06 All goods and services in the class are cancelled, namely: arranging and conducting business conferences; business marketing and management consulting services; providing information services on business, on advertising through all public communication means, on business leadership development, on business management, and on marketing and sales strategy; catalog, mail order, on-line, retail and wholesale store services of media recordings, books and printed products
Class 038. First Use: 2008/11/16 First Use In Commerce: 2008/11/16

All goods and services in the class are cancelled, namely: telecommunications services, namely, electronic, electric and digital transmission of voice, data, images, sound, signal and messages; providing information services on telecommunications via a global network; video and audio teleconferencing services; podcasting and webcasting


Class 041. First Use: 2009/05/06 First Use In Commerce: 2009/05/06

All goods and services in the class are cancelled, namely: on-line publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all featuring information on business, communications, leadership, management, marketing and sales strategy; educational and instructional services, namely, conducting educational classes, conferences, retreats, seminars and workshops on business, communications, leadership, management, marketing and sales strategy, and distributing course instructional materials in connection therewith; entertainment services, namely, live speaking performances and speaking engagements on business, communications, leadership, management, marketing and sales strategy; publication of books, magazines and newsletters


Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77947789	Application Date	03/01/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OUTSELL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1998/12/12 First Use In Commerce: 1998/12/12 Downloadable electronic publications in the nature of research reports relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management</p> <p>Class 035. First use: First Use: 1994/04/22 First Use In Commerce: 1994/04/22 Business consulting and market research services in the publishing and information industries; arranging and conducting business conferences in the publishing industry and the information industry; providing an on-line database featuring information relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory</p>		

	<p>information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management</p> <p>Class 041. First use: First Use: 1998/12/12 First Use In Commerce: 1998/12/12</p> <p>On-line journals, namely, blogs featuring information in the publishing and information industries; on-line publication of research reports relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management</p>
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U.S. Application No.	77952168	Application Date	03/05/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OUTSELL S		
Design Mark			
Description of Mark	The mark consists of the word OUTSELL to the left of a design featuring the letter "S" centered on an elongated circle of two even halves.		
Goods/Services	<p>Class 009. First use: First Use: 2007/04/24 First Use In Commerce: 2007/04/24</p> <p>Downloadable electronic publications in the nature of research reports relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management</p> <p>Class 035. First use: First Use: 2006/10/31 First Use In Commerce: 2006/10/31</p> <p>Business consulting and market research services in the publishing and information industries; arranging and conducting business conferences in the publishing industry and the information industry; providing an on-line database featuring information relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management</p> <p>Class 041. First use: First Use: 2006/10/31 First Use In Commerce: 2006/10/31</p> <p>On-line journals, namely, blogs featuring information in the publishing and information industries; on-line publication of research reports relating to the publishing industry and information industry, specifically in the fields of B2B</p>		

	trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management
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Attachments	77947789#TMSN.jpeg (1 page)(bytes) 77952168#TMSN.jpeg (1 page)(bytes) Petition to Cancel (Outsell - McCormick Team).pdf (10 pages)(107844 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/christine redfield/
Name	Christine B. Redfield
Date	07/18/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3,758,243

For the mark OUTSELL YOURSELF

Date registered: March 9, 2010

Outsell, Inc.,)	
)	
)	
Petitioner,)	
)	
v.)	Cancellation No.: _____
)	
The McCormick Team, Inc.,)	
)	
Respondent.)	
)	

PETITION FOR CANCELLATION

Outsell, Inc., a California corporation with its principal place of business at 330 Primrose Road, Suite 510, Burlingame, CA 94010 (hereinafter “Petitioner”), believes it will be damaged by the registration of the mark shown in Registration No. 3,758,243 and, therefore, seeks to cancel said registration pursuant to 15 U.S.C. § 1064 and the provisions of 15 U.S.C. § 1051 *et. seq.*

Registration No. 3,758,243 for the mark OUTSELL YOURSELF, was registered by The McCormick Team, Inc. (hereinafter “Respondent”) on March 9, 2010, for the following goods and services: “Prerecorded electronic media, namely, audio and video cassettes, CDs and DVDs all featuring information on business, communications, leadership, management, marketing and sales strategy presented through speeches, sound effects and music; downloadable webcasts and podcasts featuring music and audio books” in International Class 9; “Paper and printed matter, namely, printed publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all

featuring information on business, communications, leadership, management, marketing and sales strategy; photographs mounted and unmounted; posters; postcards; printed greeting cards; printed educational, instructional and teaching materials on business, communications, leadership, management, marketing and sales strategy; series of non-fiction books on business, communications, leadership, management, marketing” in Class 16; “Arranging and conducting business conferences; business marketing and management consulting services; providing information services on business, on advertising through all public communication means, on business leadership development, on business management, and on marketing and sales strategy; catalog, mail order, on-line, retail and wholesale store services of media recordings, books and printed products” in International Class 35; “Telecommunications services, namely, electronic, electric and digital transmission of voice, data, images, sound, signal and messages; providing information services on telecommunications via a global network; video and audio teleconferencing services; podcasting and webcasting” in International Class 38; and “On-line publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all featuring information on business, communications, leadership, management, marketing and sales strategy; educational and instructional services, namely, conducting educational classes, conferences, retreats, seminars and workshops on business, communications, leadership, management, marketing and sales strategy, and distributing course instructional materials in connection therewith; entertainment services, namely, live speaking performances and speaking engagements on business communications leadership, management, marketing and sales strategy; publication of books, magazines and newsletters” in International Class 41.

As grounds for its Petition for Cancellation, Petitioner alleges the following:

1. Since 1994, Petitioner has used the OUTSELL mark in connection with business consulting, marketing consulting and market research services in the publishing and information industries, business conferences in the publishing and information industries and providing an online database featuring information relating to the publishing and information industries. Petitioner has also used the OUTSELL mark since 1998 in connection with printed and electronic publications in the nature of research reports relating to the publishing and information industries, and on-line journals and on-line publication of research reports in the publishing and information industries.

2. On or about July 9, 2002, Petitioner obtained a U.S. Trademark Registration No. 2,590,294 for the OUTSELL & Design trademark, with Petitioner's first use and first use in commerce in 1994. Petitioner inadvertently failed to file a Section 8 Declaration required to maintain the registration, resulting in the cancellation of Registration No. 2,590,294 for its OUTSELL & Design service mark on January 9, 2009. However, Petitioner did not cease using the OUTSELL mark at any time.

3. On or about March 19, 2008, prior to the cancellation of Petitioner's registration for the OUTSELL & Design mark, Respondent filed a U.S. trademark application to register the mark OUTSELL YOURSELF. That application matured into Registration No. 3,758,243 on March 9, 2010 on the Principal Register for use in connection with the following goods and services:

"Prerecorded electronic media, namely, audio and video cassettes, CDs and DVDs all featuring information on business, communications, leadership, management, marketing and sales strategy presented through speeches, sound effects and music;

downloadable webcasts and podcasts featuring music and audio books” in International Class 9;

“Paper and printed matter, namely, printed publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all featuring information on business, communications, leadership, management, marketing and sales strategy; photographs mounted and unmounted; posters; postcards; printed greeting cards; printed educational, instructional and teaching materials on business, communications, leadership, management, marketing and sales strategy; series of non-fiction books on business, communications, leadership, management, marketing” in International Class 16;

“Arranging and conducting business conferences; business marketing and management consulting services; providing information services on business, on advertising through all public communication means, on business leadership development, on business management, and on marketing and sales strategy; catalog, mail order, on-line, retail and wholesale store services of media recordings, books and printed products” in International Class 35;

“Telecommunications services, namely, electronic, electric and digital transmission of voice, data, images, sound, signal and messages; providing information services on telecommunications via a global network; video and audio teleconferencing services; podcasting and webcasting” in International Class 38; and

“On-line publications, namely, booklets, brochures, catalogs, guides, magazines, manuals and newsletters all featuring information on business, communications, leadership, management, marketing and sales strategy; educational and instructional

services, namely, communications, leadership, management, marketing and sales strategy, and distributing course instructional materials in connection therewith; entertainment services, namely, live speaking performances and speaking engagements on business, communications, leadership, management, marketing and sales strategy; publication of books, magazines and newsletters” in International Class 41.

4. Since at least as early as 1994, long prior to Respondent’s claimed date of first use of November 16, 2008 in connection with the Class 38 services and May 6, 2009 in connection with the Class 9, 16, 35 and 41 goods and services of the OUTSELL YOURSELF mark in Registration No. 3,758,243 which is the subject of this Petition for Cancellation, Petitioner has used the OUTSELL trademark in connection with business consulting, marketing consulting, market research services, business conferences and online databases. Since at least as early as 1998, also long prior to Respondent’s claimed dates of first use of November 16, 2008 in connection with the Class 38 services and May 6, 2009 in connection with the Class 9, 16, 35 and 41 goods and services of the OUTSELL YOURSELF mark in Registration No. 3,758,243, Petitioner has used the OUTSELL trademark in connection with printed and electronic publications in the nature of research reports, on-line journals and on-line publication of research reports.

5. Petitioner uses its OUTSELL and OUTSELL S & Design trademarks in a prominent manner on its products and services as discussed above and in Petitioner’s promotional and advertising materials for its products and services, including on its Internet website where Petitioner’s products and services are offered and sold.

6. On or about March 1, 2010, upon learning of the inadvertent cancellation of its Registration No. 2,590,294 for the OUTSELL & Design trademark, Petitioner filed

U.S. Trademark Application Serial Nos. 77/947,789 and 77/952,168 to register the mark OUTSELL and OUTSELL S & Design marks on the Principal Register for use in connection with the following goods and services:

“Downloadable electronic publications in the nature of research reports relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management” in Class 9;

“Business consulting and market research services in the publishing and information industries; arranging and conducting business conferences in the publishing industry and the information industry; providing an on-line database featuring information relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit an financial information, information directories, books, magazines, and information management.” In Class 35;

“On-line journals, namely, blogs featuring information in the publishing and information industries; on-line publication of research reports relating to the publishing industry and information industry, specifically in the fields of B2B trade publishing and company information, IT and telecom research, reports and services, legal, tax and

regulatory information, market research, scientific, technical and medical information, search, aggregation and syndication of content and information, education and training, credit and financial information, information directories, books, magazines, and information management” in Class 41.

7. Petitioner’s date of first use in commerce of the OUTSELL mark for the above-referenced services in International Class 35 is April 22,1994. Petitioner’s date of first use in commerce of the OUTSELL mark for the above-referenced goods and services in International Classes 9 and 41 is December 12, 1998.

8. Petitioner’s first use in commerce of its OUTSELL mark pre-dates the filing date of Respondent’s intent to use application upon which Registration No. 3,758,243 is based and also Respondent’s claimed dates of first use of November 16, 2008 for the Class 38 services and May 6, 2009 for the Class 9, 16, 35 and 41 goods and services in Registration No. 3,758,423.

9. On January 16, 2011 office actions issued in connection with Petitioner’s Application Serial Nos. 77/947,789 and 77/952,168 citing Respondent’s Registration No. 3,758,243 for the OUTSELL YOURSELF mark as a bar to registration of the OUTSELL and OUTSELL S & Design marks under Section 2(d) of The Lanham Act, 15 U.S.C. §1052(d).

10. For over a decade prior to Respondent’s registration and use of the OUTSELL YOURSELF mark Petitioner has prominently and extensively used, promoted and advertised its products bearing the trademark OUTSELL. Petitioner has spent substantial sums advertising and promoting its products that are sold using the OUTSELL trademark.

11. As a result of Petitioner's extensive sales, marketing efforts, advertising and promotional efforts concerning the goods and services bearing the OUTSELL trademark, the trademark has developed recognition in the United States among customers for these products and services, and is uniquely associated with Petitioner. Petitioner owns all of the valuable goodwill associated with its OUTSELL trademark.

12. Upon information and belief, Respondent The McCormick Team, Inc. is a company with an address of 30765 Pacific Coast Highway, Suite 358, Malibu, California 90265.

13. Respondent's OUTSELL YOURSELF trademark is substantially similar in sound, meaning, overall appearance and commercial impression to Petitioner's OUTSELL and OUTSELL S & Design trademarks.

14. Upon information and belief, the goods and services offered by Respondent under the OUTSELL YOURSELF trademark are identical, substantially similar and/or related to the goods and services offered by Petitioner under the OUTSELL and OUTSELL S & Design trademarks and identified by Petitioner in its Applications for the OUTSELL trademarks.

15. Petitioner's goods and services offered under the OUTSELL and OUTSELL S & Design trademarks and Respondent's goods and services offered under the OUTSELL YOURSELF trademark are likely to be offered to the same types of users and/or purchasers.

16. Petitioner is not related or connected in any way to the Respondent or Respondent's use of the trademark OUTSELL YOURSELF.

17. If Respondent's mark is not cancelled, Respondent will maintain a nationwide right to use the OUTSELL YOURSELF trademark, which is likely to cause confusion with Petitioner's OUTSELL and OUTSELL S & Design trademarks in commerce, and as such, would be damaging to Petitioner's rights.


18. Petitioner is likely to be damaged by the continued registration of Respondent's mark. Petitioner's continued use and application to register its mark is adversely impaired by the continued registration of Respondent's mark.

WHEREFORE, Petitioner prays that Registration No. 3,758,243 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Petitioner hereby appoints the law firm of K&L Gates LLP, composed of attorneys in good standing and members of the bar in the U.S., among other jurisdictions, to act as attorneys of record for Petitioner herein, with full power to prosecute said Petition, to transact all relevant business with the PTO and in the United States Courts and to receive all official communications in connection with this Petition for Cancellation.

Date: July 18, 2011

Respectfully submitted,


Christine B. Redfield, Esq.
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Attorneys for Petitioner Outsell, Inc.

Certificate of Mailing

I, Mae Rubida, do certify that on July 18, 2011, this **Petition for Cancellation** was filed via electronic means (ESTTA) with the:

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Mae Rubida

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Certificate of Service

I, Mae Rubida, hereby certify that on July 18, 2011, I mailed by air mail, postage prepaid, a true and correct copy of this **Petition for Cancellation** to the following owner of record:

The McCormick Team, Inc.
30765 Pacific Coast Highway, Suite 358
Malibu, CA 90265



Mae Rubida